

**REMARKS**

Claim 7 has been rejected under § 112 due to lack of antecedent support for the second silverware basket. Applicant has changed the dependency of claim 7 to claim 6 so as to provide proper antecedent support. Thus, the § 112 rejection is moot.

Claims 1, 2, 6, 8, 9, and 12-16 have been rejected under 35 U.S.C. § 103 as being obvious over Dingler in combination with Jenkins '917, Jenkins '764, Favaro U.S. Patent Publication No. 2003/0037809, Durazani '740 or the German '887 patent. Claims 3-5, 7, 10 and 11 have been rejected under § 103 on the same combinations of claim 1, and in further view of Stottmann '294. Applicant respectfully traverses these rejections, and requests reconsideration of the claims.

Independent claims 1 and 9 each require upper, lower and middle racks mounted in the dishwasher cabinet, and a silverware basket mounted to the door of the dishwasher. In the rejections of the claims, the Examiner acknowledges that the primary reference, Dingler, does not have three racks, as required by the claims, but rather has two racks in the dishwasher cabinet and a silverware basket on the door. The Examiner then asserts that the secondary references show three racks in a dishwasher, such that Dingler could be modified to add a third rack, in accordance with claims 1 and 9. However, at best, the cited references provide no suggestion for a third rack in the Dingler dishwasher cabinet, and several of the secondary references teach away from a third rack mounted in the dishwasher cabinet, as required by the claims.

More particularly, Favaro only shows two racks, and one of them is mounted on the door, rather than in the cabinet. Durazani shows three racks, but one rack is mounted on the door, and therefore does not suggest three racks mounted in the cabinet in accordance with claims 1 and 9. The two Jenkins patents also teach away from the present invention, since the lower rack in Jenkins must roll out along the door, as seen in Figures 2-4 of the '769 patent. It is noted that

Figure 1 of the two Jenkins patents are identical with the respect to the lower rack, such that the lower rack in the '917 Jenkins patent also necessarily rolls out along the door. However, such a lower rack cannot be added to the Dingler cabinet, since the front wall 42 of the silverware basket in Dingler resides above the inside surface of the door, as seen in Figure 1.

The German patent teaches away from the asserted combination, since silverware baskets are provided in the upper or lower rack, as seen in Figures 1-3. Thus, the German patent suggests that it is unnecessary to provide a silverware basket on the door, as in Dingler, such as the combination of Dingler and the German patent is not suggested.

Furthermore, in Dingler, there is very little space between the two the racks. As seen in Figure 1, the bottom of the upper rack is very close to the top of the lower rack. Thus, there is no space in Dingler for a third rack in the cabinet.

As the Federal Circuit in has stated:

Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under §103, teaching of references can be combined only if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added) *In re Fritch*, 23 U.S.P.Q. 1780, 1783-84 (Fed. Cir. 1992).

It was further stated by the Federal Circuit in *Ex Parte Levengood* that:

"...an Examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence that the motivating force which would compel one skilled in the art to do what the patent applicant has done." *Ex Parte Levengood*, 28 U.S.P.Q.2d 1300, 1302 (Fed. Cir. 1993).

As the Board of Patent Appeals and Interferences has stated, citing references which merely indicate that isolated elements and/or features recited in claims are known is not sufficient basis for concluding that the combination of claimed elements would have been obvious." *Ex parte Hyamizu*, 10 U.S.P.Q.2d 1393, 1394 (B.P.A.I. 1988).

In short, as stated by the Federal Circuit,

"It is wrong to use the patent-in-suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims-in-suit."

*Orthopedic Equipment Company v. United States*, 702 F.2d 1005, 1012, 217 U.S.P.Q. 193, 199 (Fed. Cir. 1983).

The Federal Circuit has also explained that there must be "some objective teaching" leading to the combination. *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. 1992). As further explained in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) this showing must be "clear and particular."

Here, there is no clear and objective teaching or suggestion for combining the secondary references with Dingler. Therefore, there is no prima facie case of obviousness with respect to independent claims 1 and 9.

Accordingly, independent claims 1 and 9 distinguish over the cited references so that as to be in proper form for allowance. The dependent claims are allowable if dependent from an allowable base claim.

Claim 9 also requires a molded hook on the door for hanging the silverware basket. The Examiner asserts that the Dingler patent inherently has the equivalent of hooks. However, Dingler has no drawings or description regarding any type of hook, but merely refers to patent 3,665,943. The '943 patent shows a screw and flanged button 31 on the door for hanging a

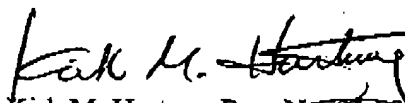
silverware basket. However, a screw is not equivalent to molded hook. A screw is a separate component added after the door is manufactured. In comparison, a molded hook is formed during the manufacturing process of the door liner. There is no evidence that a molded hook is equivalent to a screw. Therefore, claim 9 further distinguishes over the cited references.

Dependent claim 8 also distinguishes over the cited references by requiring that the basket resides "substantially within the recess with the lower rack overlying the basket when in the extended position." New claim 17 depends from claim 9 and has a similar limitation in that the lower rack is "rollable along the door and over the silverware basket." As seen in Figure 1 of Dingler, the basket extends above the outer perimeter of the door where a lower rack would roll. The Dingler basket thus precludes the roll out of a lower rack. Accordingly, claims 8 and 17 are in proper form for allowance.

In view of the foregoing Applicant respectfully requests that an issue of allowance be issued.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Respectfully submitted,



Kirk M. Hartung Reg. No. 31,021  
McKEE, VOORHEES & SEASE, P.L.C.  
801 Grand Avenue, Suite 3200  
Des Moines, Iowa 50309-2721  
Phone No: (515) 288-3667  
Fax No: (515) 288-1338  
**CUSTOMER NO: 27139**

Attorneys of Record